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October 8, 2015

VIA ECF

Honorable Judge Ronald L. Ellis
United States Magistrate Judge
Daniel Patrick Moynihan U.S. Courthouse
500 Pearl Street
New York, New York 10007-1312

RE: *Infinity Headwear & Apparel, LLC v. Jay Franco & Sons, et al.*, No. 15-1259-JPO-RLE
Letter Requesting that Jay Franco's Responsive Claim Construction Brief be Stricken and Requesting an Extension of Time to File Claim Construction Reply

Honorable Judge Ellis,

Plaintiff, Infinity Headwear & Apparel, LLC ("Infinity"), by and through its counsel of record, hereby respectfully requests that Defendants Jay Franco & Sons, Inc. and Jay at Play, Int'l HK Ltd.'s (collectively, "Jay Franco") Responsive Claim Construction Brief, including additional documents filed in support thereof (Docket Entry ("D.E.") Nos. 99 – 101), be stricken for failing to comply with this Court's Individual Practices and that Jay Franco be required to re-file a compliant brief.

Specifically, in this case, "[a]ll motions and applications shall be governed by the Court's Individual Practices." (*See* D.E. No. 37 at ¶ 9.) To this end, the Honorable District Court Judge J. Paul Oetken's Individual Practices in Civil Cases, Rule 2(C), state that "[m]emoranda of law in support of and in opposition to motions are limited to 25 pages, and reply memoranda are limited to 10 pages." Pursuant to Judge Oetken's Individual Practices, Infinity's Opening Claim Construction Brief was limited, as required, to 25 pages. (*See* D.E. No. 96.) Indeed, Infinity diligently worked to keep its Opening Claim Construction Brief within the required page limit. Jay Franco, however, today filed its Responsive Claim Construction Brief comprising 35 pages. (*See* D.E. No. 99.) As Jay Franco's brief exceeds the page limit by 10 pages, and Jay Franco did not seek leave to file an over length brief, Jay Franco's brief should be stricken as non-compliant and Jay Franco should be required to re-file a compliant brief. This is particularly true here, as Infinity's compliance with the applicable rules will put Infinity at a prejudicial disadvantage if Jay Franco's over-length brief is not stricken and refiled as Infinity limited its opening argument to only 25 pages and will be limited to responding to Jay Franco's 35 pages in only 10 pages. Simply put, Jay Franco's non-compliant brief must be stricken and refiled as required under the applicable rules so as to avoid undue prejudice to Infinity in the critical claim construction briefing process.

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In addition, it is notable that Jay Franco's non-compliant over length brief improperly sets forth, at length, arguments pertaining to non-infringement and/or patent invalidity. (*See* D.E. No. 99, *passim*.) These topics, however, are appropriate for dispositive motions, not claim construction briefing. Indeed, Jay Franco's prior request to short circuit the orderly progression of this case has already been rejected by Judge Oetken. Specifically, Jay Franco already sought permission to file a motion for summary judgment. (*See* D.E. No. 74.) That request was explicitly denied and the Court admonished Jay Franco to "follow the Local Patent Rules and the Scheduling Order…." (D.E. No. 81.) Nevertheless, in violation of the Court's instruction, Jay Franco has exceeded the 25 pages permitted for its claim construction response, in part, due to lengthy arguments regarding non-infringement and patent invalidity. This further augments the prejudice to Infinity in having to respond to Jay Franco's non-compliant brief as Infinity limited its Opening Claim Construction Brief solely to the issue at hand: claim construction. If Infinity is forced to respond to Jay Franco's response as filed, Infinity will unfairly be compelled to address, for the first time in its reply, dispositive issues which Jay Franco has set forth far in excess of the page limit. The Court should not permit Jay Franco's non-compliant brief to remain on file where the excessive pages are used to set forth unnecessary and inappropriate dispositive arguments at the claim construction phase of this case.

In addition, as Jay Franco's non-compliant brief should be stricken and refiled, Infinity hereby respectfully requests an extension of the deadline to file its forthcoming claim construction reply. Under the Court's Patent Case Scheduling Order, and pursuant to Local Patent Rule 12(c), Infinity's claim construction reply would normally be due "seven (7) days after service of the response," i.e., Thursday, October 15, 2015. LOCAL PATENT RULE 12(c). (D.E. 37 at ¶ 8(f).) This is already a short turn around given that Jay Franco is afforded thirty (30) days to prepare and file its Responsive Claim Construction Brief. LOCAL PATENT RULE 12(b). (D.E. 37 at ¶ 8(e).) Here, however, Jay Franco's non-compliant brief has imposed an undue burden on Infinity of having to either quickly respond to a non-compliant brief or simultaneously prepare a reply thereto while seeking to strike the non-compliant brief. Under such circumstances, an extension of Infinity's deadline relative to the day on which Jay Franco ultimately refiles a compliant brief is warranted.

In addition, however, Jay Franco's non-compliant Responsive Claim Construction Brief is based, in part, on the forty-five (45) page Declaration of Dr. David Brookstein in Support of Defendants' Responsive Claim Construction Brief. (*See* D.E. No. 101.) While it is certainly Jay Franco's prerogative to rely on an extensive expert declaration despite the simple technology and straightforward patent at issue, Jay Franco has never provided any advance notice of Dr. Brookstein's involvement and Infinity will be prejudiced by having to respond to Jay Franco's briefing without the opportunity to depose Dr. Brookstein in advance. To this end, Infinity respectfully request that, after Jay Franco refiles a compliant brief, the parties be ordered to meet and confer regarding a suitable time and location for Dr. Brookstein's deposition and that Infinity be granted an extension of the deadline to file its claim construction reply until seven (7) days after the deposition transcript from Dr. Brookstein's deposition is available to both parties.

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We thank the Court for its attention to these matters; we would be happy to provide any additional information necessary to facilitate the Court's review of this matter.

Respectfully,

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